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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,798	12/05/2003	Roy Hirst	MS305474.01/MSFTP1150US	2266
27195 7590 12/17/2007 AMIN. TUROCY & CALVIN, LLP 24TH FLOOR, NATIONAL CITY CENTER 1900 EAST NINTH STREET CLEVELAND, OH 44114			EXAMINER PEARSON, DAVID J	
			ART UNIT 2137	PAPER NUMBER
			NOTIFICATION DATE 12/17/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/729,798	Applicant(s) HIRST, ROY	
	Examiner David J. Pearson	Art Unit 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 11, 16 and 21 have been amended. Claims 1-23 have been examined.

Response to Arguments

2. Applicant's arguments, filed 09/27/2007, with respect to the rejection(s) of claim(s) 1-23 under 35 U.S.C. 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Friedman et al. (U.S. Patent 7,039,806).

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Objections

4. Claims 6-10 are objected to because of the following informalities:

Claim 6 recites, "... independent of an a particular operating system..." Examiner believes this to be a typographical error and applicant intends the claim to read "...independent of a particular operating system..." like currently found in claim 21.

Claim 23 is objected to because of the following informalities:

Claim 23 recites, "...wherein the auditable document history log..." This limitation lacks antecedent basis because "an auditable document history log" has not been introduced in claim, which claim 23 depends on. Examiner believes claim 23 should depend on claim 22 because that claim does introduce "an auditable document history

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log" and will treat the claims as such for the remainder of the Office Action. Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. Claims 16-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 16-23 recite, "A computer readable medium..." Claims 16-23 are not limited to tangible embodiments. In view of applicants' disclosure, specification paragraph 15, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., storage medium) and intangible embodiments (e.g., communication media). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

To overcome the 35 U.S.C. 101 rejection, examiner recommends applicant amend claims 16-23 to recite, "A computer readable storage medium..." like currently found in claim 11.

Claim Rejections - 35 USC § 102

6. Claims 1-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Friedman et al. (U.S. Patent 7,039,806).

For claims 1, 11 and 16, Friedman et al. teach a method and computer readable storage medium of storing digitally encoded material, the method comprising:

Associating a unique identifier (note column 3, lines 44-46) with digitally encoded material (note column 3, lines 11-14); and

Associating one or more built-in functions (note column 3, lines 51-60) with digitally encoded material such that the unique identifier and the built-in functions are coupled to the digitally encoded material (note column 4, lines 57-65); **and**

Rendering or transforming the digitally-encoded material **based on the built-in functions** (note column 5, lines 23-29).

For claims 2 and 17, Friedman et al. teach claims 1 and 16 further comprising:

Associating a history of the digitally encoded material with the digitally encoded material (note column 3, lines 62 through column 4, line 5).

For claims 3 and 18, Friedman et al. teach claims 1 and 16 further comprising:

Associating a history of the digitally encoded material, the wherein the history being located in a database (note column 3, lines 62 through column 4, line 5).

For claims 4 and 19, Friedman et al. teach claims 1 and 16 wherein the built-in function includes one or more of Copy or Paste and Print (note column 4, lines 22-29).

For claims 5, 12 and 20, Friedman et al. teach claims 1, 11 and 16 wherein the associating the built-in functions with the digitally encoded material enables the digitally

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encoded material to be stored in RAM in an encrypted form (note column 5, lines 55-58).

For claims 6 and 21, Friedman et al. teach a method and computer readable medium for tracking digitally encoded material, the method comprising:

Appending a unique identifier (note column 3, lines 44-46) to the digitally encoded material (note column 3, lines 11-14);

encrypting a combination including the digitally encoded material and the unique identifier (note column 3, lines 47-49); and

appending built-in function source code and the encrypted combination to form an executable entity (note column 4, lines 57-65) capable of being executed independent of a particular operating system (note column 5, lines 23-29).

For claim 7, Friedman et al. teach claim 6 wherein the built-in functions include one or more of Copy, Paste and Print (note column 4, lines 22-29).

For claims 8 and 13, Friedman et al. teach claims 6 and 11 wherein the built-in functions include rendering functions and transform functions (note column 3, lines 51-60).

For claims 9 and 14, Friedman et al. teach claims 8 and 13 wherein the rendering functions include one or more of a close, find shape, full screen, go to guide, help, open

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(note column 3, lines 51-60), order pan, properties, reveal, rotate/flip, search, select, size, and position, spell check and zoom.

For claims 10 and 15, Friedman et al. teach claims 8 and 13 wherein the transform function include one or more of copy (note column 3, lines 51-60), DRM agent, encrypt/decrypt, export, insert, log, new, paste, print, replace, save as.

For claim 22, Friedman et al. teach claim 21 wherein the acts further comprises: tracking the digitally encoded material by maintaining an auditable document history log (note column 3, lines 62 through column 4, line 5).

For claim 23, Friedman et al. teach claim 22 wherein the auditable document history log is maintained in one of a file associated with the digitally-encoded material and a database independent of the digitally-encoded material (note column 3, lines 62 through column 4, line 5).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kocher et al. (U.S. Patent Application Publication 2002/0141582) teach content media that includes code, which helps determine if the player is authorized for playback

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(note Abstract, paragraphs [0043]-[0049]). Kocher et al. also teach a secure memory for storing the history of content playback (note paragraph [0092]).

Kyle (U.S. Patent 6,141,681) teaches a data package, including an instruction portion and a data portion. The receiving computer uses the instruction portion to the process the data portion (note column 3, lines 51-55).

Collins, III et al. (U.S. Patent 5,845,090) teach creating packages by combining software and data with programs and data called methods that are operable on computers to act on the software and data (note column 1, lines 37-44).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Pearson whose telephone number is (571) 272-0711. The examiner can normally be reached on Monday - Friday, 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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